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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,915	01/16/2004	Michael A. Pellico	51831/WPC/D279	7064

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EXAMINER
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KRASS, FREDERICK F

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/758,915

Applicant(s)

PELLICO, MICHAEL A.

Examiner

Frederick F. Krass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **Previous Rejections**

Unless specifically maintained infra, all previous rejections are withdrawn.

### **Obviousness Rejection (Previous)**

1) Claims 1-10 and 25-32 were rejected under 35 USC 103(a) as being unpatentable over Ostler (USP 6,116,900) in view of Jensen (USP 5,858,332).

This rejection is withdrawn with regard to claims 1-10. (Applicant has amended these claims to exclude heat or radiant energy activatable compositions, subject matter which is free of prior art since it is essentially the same as that previously allowed in copending Application No. 10/045,184).

This rejection is maintained with regard to claims 25-32.

Applicant argues that the primary reference does not provide any motivation for one of skill in the art to use a mixture of hydrogen peroxide and carbamide peroxide in a two-component dental bleaching system since it is "mainly concerned" with a one-component composition having sufficient shelf-life. (Remarks, p. 15, ¶ 2).

This argument is not found persuasive; the prior art teaching that bleaching activity can be varied by adjusting the relative proportions of carbamide peroxide and hydrogen peroxide is a generic one, and relates to the activity of the peroxides following their application to teeth, not their activity while in storage. Accordingly, the teaching is relevant to bleaching compositions generally, be they one or two part. (The peroxides are blended together when they are applied to the teeth, regardless of whether their original source was a one part or two part composition).

Applicant further argues that the secondary reference teaches away from such combinations in stating that "it will be preferable to use concentrated hydrogen peroxide solutions when it is desired to manufacture a bleaching composition having high concentrations of bleaching agent" at col. 1, lines 52-55. (Remarks, p. 17, ¶ 2). This argument is not understood. The reference clearly does disclose

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combining the two peroxides, and the teaching at issue merely relates to mixtures at the high end of the scale, i.e., those comprising predominantly hydrogen peroxide, and containing only minor amounts of carbamide peroxide. This is merely an exemplification of one particular embodiment, not a "teaching away" from the general concept.

2) Claims 11, 12, 33 and 34 were rejected under 35 USC 103(a) as being unpatentable over Ostler (USP 6,116,900) in view of Jensen (USP 5,858,332), the combination being taken further in view of Norfleet (USP 5,486,350).

This rejection is withdrawn with regard to claims 11 and 12.

This rejection is maintained with regard to claims 33 and 34.

Since rejection "1") supra is maintained with regard to claim 25-32, Applicant's argument that the instant rejection should be withdrawn because that rejection has been overcome is moot. (See Remarks, p. 19, ¶ 4).

**Provisional Obviousness-Type Double Patenting Rejection (New, Necessitated by Amendment)**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 and 16-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 17-26 of copending Application No. 10/045,184. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because, as now amended, the instant and conflicting claims are drawn to substantially the same subject matter, differing only by specific language used and/or via overlap in scope by generic/subgeneric relationship. (Regarding the instant method claims (25-34), it would have been obvious in a self-evident manner to have used the conflicting bleaching compositions in methods for bleaching teeth).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Action is Final, Necessitated by Amendment**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Krass whose telephone number is 571-272-0580. The examiner's schedule is 9:30AM – 6:00PM, Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached at 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick Krass  
Primary Examiner  
Art Unit 1614

A handwritten signature in black ink, appearing to be 'F. Krass', written over the printed name and title.